

claims 5-13 and 24-35 have been cancelled and new claims 36-56 added. Accordingly, claims 1-4, 14-23 and 36-56 are now pending.

The Indefiniteness Rejections

It is respectfully contended that the term “substantial-cut lines” is definite, as is the term “extending substantially.” One of ordinary skill in the art when reviewing the subject disclosure would know what was meant by “substantial cut lines” and “extending substantially”. See, In re Mattison, 184 USPQ 484 (CCPA 1975) and Andrew Corp. v. Gabriel Electronics, 6 USPQ 2d 2010 (Fed Cir 1988).

Numerous examples of the substantial-cut lines are provided throughout the subject disclosure. For example, on page 2, line 16, it states that the lines extend about 90% through the thickness of the sheet from the front towards the back surface. Another example is disclosed on page 3, first full paragraph where it says that the “substantial-cut lines can be formed by scoring the sheet part way on both faces of the sheet. Thereby the intact portion of the sheet along these lines will be at the middle (approximately ten or twenty percent) thickness of the sheet.”

The first full paragraph on page 7 is also applicable. It states that

[a]t least one of the defining lines is a “substantial-cut” line 170, cut along its entire length, substantially but not all the way through the paper 160; that is cut through the top surface 174 of the paper approximately ninety percent the way through towards the bottom surface 178. This is shown in an enlarged view in FIG. 6. A preferred embodiment has a substantial cut line(s) 170 extending 9.3 to 9.5 mil through a ten mil thick card stock. Alternatively, they can extend between seventy and ninety-eight percent of the distance therethrough. The substantial-cut lines 170 can be formed by trimming wheels (rotary knives), by die cutting, laser scoring, or chemical or acid etching.”

Page 9 also discusses substantial-cut lines as follows “[a]s described above, relative to FIG. 6, the substantial-cut lines can be formed through one side (or face) of the paper 160. An alternative embodiment forms the substantial-cut line by “cutting” (or penetrating) the sheet from both sides, as shown in FIG. 7, by top cut or penetration 250 and bottom cut or penetration 254, leaving a thin center piece 258. These two penetration lines 250, 254 can be formed by trimming wheels (rotary knives) by die cutting, laser scoring, or chemical or acid etching. Preferably, they are formed with a scoring process.

If the paper 160 is a ten mil sheet, the top and bottom scorings 250, 254 can each be two mil leaving about sixty percent of the fibers intact in the center 258. Alternatively, the scorings can even be 4.75 mil from both sides leaving the center 258 only one-half mil thick (or any distance in between). The sheet 160 with this thin center 258 will have enough integrity not to fall apart depending on the kind of paper used and the configuration of the printer path. If the path is very convoluted, the one-half mil may not be enough, but for (printers with) straight paths it will likely be sufficient. Half mil thickness may also be sufficient where the paper 160 has long fibers, or where the paper has not been supercalendered or otherwise made brittle as discussed above.

Scoring on both sides tends to give the card (or printed media) when separated from the rest of the sheet a cleaner edge. One reason for this is that the separated fibers are in the middle of the sheet, not hanging out from either the top or bottom. When they are in the middle of the sheet 160 (that is, the middle of the thickness of the paper), they are likely to be less visible to the human eye.

The Abstract also says that “[t]he business cards separate cleanly along the substantial-cut lines, superior to the microperforated business card separation lines.”

Accordingly, it is clear that those skilled in the art would understand and know what is meant by “substantial-cut lines”.

Similarly, those skilled in the art when considering this disclosure would understand what is meant by “weakened separation lines”. Weakened separation lines can, for example, be score lines. They alternatively can be through-cut lines.

The Rejection Over the Bishop Patent

The Examiner in rejecting the claims over the ‘587 Bishop patent stated that while Bishop does not disclose substantial-cut lines, it does state “similarly, additional perforations 44 such as those illustrated in FIG. 5 may be added to facilitate the use of the cards in RolodexTM type card files. The perforation design is limited to the illustrated embodiments. Other varieties of perforation shapes may be employed depending on the type of printing job for which the sheet will be used.”

This quote simply means that the perforated design can be different from those illustrated in the drawings such as to form differently shaped cards and the like. It in no way suggests that the perforated lines are to be replaced with substantial-cut lines. The Examiner’s statement that it would have been obvious to include substantial-cut lines is clearly not suggested by the prior art; this rejection constitutes impermissible hindsight, Applicant respectfully contends.

The Double Patenting Rejection

An obviousness-type double patenting rejection was made over the ‘332 application. Applicant first notes that the rejection was provisional. Reconsideration of this provisional rejection is requested in view of the fact that the present claims are directed to an apparatus and the claims in the ‘332 application are directed to a method. It also is contended that an

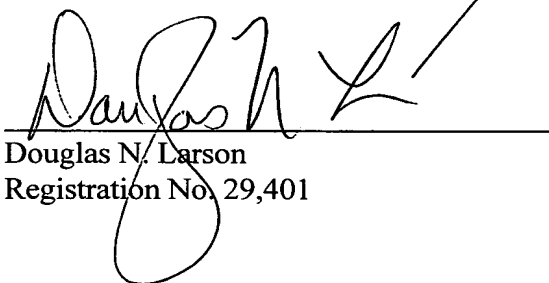
obviousness-type double patenting rejection over claims in the U.S. Patent 5,853,837 is not in order.

Concluding Remarks

Accordingly, it is respectfully contended that the subject application is in condition for allowance. Early issuance of the Notice of Allowance is in order. If there are any remaining issues, the Examiner is encouraged to telephone counsel to seek to resolve them.

Additionally, if any fees are due for this Amendment, the Commissioner is authorized to charge them to Deposit Account Number 16-2230.

Respectfully submitted,



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